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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/612,055	07/07/2000	Joseph H. Sklar	SKLAR-21	6809

7590 01/31/2005

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EXAMINER

BUMGARNER, MELBA N

ART UNIT	PAPER NUMBER
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3732

DATE MAILED: 01/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/612,055	SKLAR, JOSEPH H. ED	
	Examiner	Art Unit	
	Melba Bumgarner	3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>3/15/04</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 16 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear what is meant by “the other of said at least one of surfaces being arc-shaped is a flat surface.”

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 14, 15, and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Jacobs (4,750,492). Jacobs discloses a ligament shim comprising a body 24' having a first end and a second end, and an axis extended from the first end to the second end, the first and second ends being substantially planar and of substantially the same configuration, substantially the same size, and normal to the axis, at least two surfaces extending from the first end to the second end and substantially parallel to the axis, at least one of the two surfaces being arc-shaped; and a shim hole 28 extending from the arc-shaped surface to the other of the at least two surfaces, the body being devoid of further opening. Patentable weight is not given to the intended use of the

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“shim”. The arc-shaped surface extends outwardly from the axis. The at least two surfaces comprise four surfaces including two arc-shaped surfaces and two outwardly rounded surfaces.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 14-17 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Luscombe et al. (5,683,418). Luscombe et al. disclose a ligament shim for insertion into a bone tunnel comprising a body 100 having a first end and a second end, and an axis extended from the first end to the second end, the first and second ends being substantially planar and of substantially the same configuration, and normal to the axis, at least two surfaces extending from the first end to the second end and substantially parallel to the axis, at least one of the two surfaces being arc-shaped; and a shim hole 102, the body being devoid of further opening; however, they do not show the first and second end being substantially the same size and the hole extending from the arc-shaped surface to the other of two surfaces. It would have been an obvious matter of choice to one having ordinary skill in the art at the time the invention was made as to the size of the ends and the locating of the hole as the disclosure does not show any criticality to these features in the claimed invention. The specification states that in one form of the invention, the shim can be tapered so as to give it a wedge-like configuration and that in another form of the invention, the shim can have a hole. The arc-shaped surface extends outwardly from the axis.

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7. Claims 14-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim (6,355,066). Kim discloses a ligament shim for insertion into a bone tunnel comprising a body having a first end and a second end, an axis extending from the first end to the second end, at least two surfaces extending from the first end to the second end and substantially parallel to the axis, at least one of the two surfaces being arc-shaped and a shim hole 22 extending from the arc-shaped surface to the other of the two surfaces; however, Kim does not show the first and second ends as claimed and the body devoid of further opening. It would have been an obvious matter of choice to one having ordinary skill in the art at the time the invention was made as to the size and shape of the ends and the number of openings in the body as the disclosure does not show any criticality to these features in the claimed invention. The specification states that in one form of the invention, the shim can be tapered so as to give it a wedge-like configuration, that in another form of the invention, the shim can have a hole, and the specification does not disclose anywhere that the body must be devoid of any opening other than the shim hole. The arc-shaped surface extends outwardly from the axis. The two surfaces are arc-shaped surfaces and are opposed surfaces and extend inwardly toward each other. The surfaces comprise four surfaces including two arc-shaped surfaces and two outwardly rounded surfaces.

Response to Arguments

8. Applicant's arguments with respect to the rejected claims have been considered but are moot in view of the new ground(s) of rejection.

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Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melba Bumgarner whose telephone number is 571-272-4709.

The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached at 571-272-4720. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Melba Bumgarner
Patent Examiner